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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/888,532
Filing Date: June 25, 2001
Appellant(s): DOERR ET AL.

Jack M. Cook
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 8 February 2007 appealing from the Office action mailed 5 October 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is incorrect. In the brief filed 8 February 2007, Appellant indicated the status of the claims to be as follows: Claims 1-21 are pending. Claims 1, 7, 10-12, 15, and 17-21 have been finally rejected under 35 U.S.C. 102(b) and claims 2-6, 8, and 9 have been finally rejected under 35 U.S.C. 103(a). Appellant's statement regarding the status of the above noted claims is correct, however, Appellant has neglected to provide the status of claims 13-14 and 16. As Appellant has correctly indicated the status of claims 13-14 and 16 in the "grounds of rejection to be reviewed on appeal" below, Examiner assumes an oversight on the part of Appellant.

A correct statement of the status of the claims is as follows: Claims 1-21 are pending. Claims 1, 7, 10-12, 15, and 17-21 have been finally rejected under 35 U.S.C. 102(b). Claims 2-6, 8-9, 13-14, and 16 have been finally rejected under 35 U.S.C. 103(a).

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,924,074	Evans	7-1999
5,845,255	Mayaud	12-1998

Abbo, United States Patent Application Publication 2003/0195774

Rappaport, United States Patent Application Publication 2002/0007285

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 7, 10-12, 15, 17-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Evans (United States Patent #5,924,074).

[A] As per independent claim 1, Evans teaches a patient-side decision support system comprising: a hand-held terminal usable during an examination and providing a display and user input device (Evans; Abstract, col. 2, lines 47-50 and col. 13, lines 13-22); a terminal server communicating with the hand-held terminal and holding medical information related to medical diagnoses as linked to a set of diagnosis codes (Evans; col. 11, lines 10-22, col. 12, lines 66-67, and col. 13, lines 1-4), the terminal server further executing a stored program to: (a) accept from the user input device of the hand-held terminal, input designating a methodology producing a subset of diagnoses codes (Evans; col. 11, lines 40-52); (b) present on the display of the hand-

Art Unit: 3623

held terminal a navigation menu a representation of the subset of the diagnosis codes generated using the selected methodology (Evans; col. 6, lines 40-55 and col. 11, lines 30-40); (c) accept from the user input device of the hand-held terminal a selection of a particular diagnosis codes from the subset (Evans; col. 11, lines 46-50); and whereby a comprehensive set of diagnosis codes can be present to the physician on a hand-held device at the time and location of patient examination (Evans; col. 14, lines 62-65).

[B] As per dependent claim 7, Evans teaches a system wherein the methodology provides a hierarchy having at least one level of diagnosis code groupings holding a predetermined set of related diagnosis codes that may be selected by the user to reveal the subset of diagnosis codes (Evans; col. 11, lines 40-46).

[C] As per dependent claim 10, Evans teaches a system wherein the diagnosis codes are ICD-9 codes (Evans; col. 9, lines 4-7).

[D] As per dependent claim 11, Evans teaches wherein a system the terminal server further includes a table selecting only a subset of the ICD-9 codes to include in the set of diagnosis codes selectable by the user (Evans; col. 9, lines 4-7).

[E] As per dependent claim 12, Evans teaches a system wherein the terminal server further executes a stored program to: (d) provide to the user the medical information linked to the selected diagnosis codes (Evans; col. 11, lines 17-22).

[F] As per dependent claim 15, Evans teaches a system wherein the medical information is selected from the group consisting of relevant treatment options, patient handouts, and physician education information (Evans; col. 11, lines 15-22).

[G] As per dependent claim 17, Evans teaches a system wherein the display provides a resolution of at least 600 X 200 pixels (Evans; col. 12, lines 57-63, and col. 13, lines 14-22).

[H] As per dependent claim 18, Evans teaches a system wherein the hand-held terminal provides a wireless link communicating with the terminal server (Evans; Abstract and col. 13, lines 15-22).

[I] As per dependent claim 19, Evans teaches a system wherein the physician input device is selected from a keyboard and stylus entry device (Evans; Abstract and col. 6, lines 60-65, col. 7, lines 11-14).

[J] As per dependent claim 20, Evans teaches a system wherein the display is a graphic display providing for the display of text and images (Evans; col. 5, lines 55-60 and col. 6, lines 60-65, and col. 7, lines 11-14).

[K] As per dependent claim 21, Evans teaches system wherein the terminal server and the hand-held terminal provide interfaces connecting to the Internet and wherein the terminal server connects with the hand-held terminal via the Internet (Evans; col. 12, lines 55-67 and col. 13, lines 1-29).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-6 and 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Evans in view of Abbo (United States Patent Application Publication #2003/0195774).

[A] Regarding claims 2-6, and 8 Evans does not teach the retrieval of the most frequently used diagnostic codes for a predetermined set of physicians (claims 2 and 8) or for a predetermined set of physicians practicing a common specialty (claim 3). Further, Evans does not teach identifying the user and providing the most commonly used diagnosis codes for the user (claims 4 and 8) or providing the most recent diagnostic codes for the patient (claims 5 and

8). Lastly, Evans does not teach providing diagnostic codes previously selected for the user that have not been removed by editing (claim 6).

[B] As per dependent claim 2, Abbo teaches a system wherein the methodology provides the most frequently used diagnosis codes for a predetermined set of physicians as the subset of diagnosis codes (Abbo; paragraph [0058]).

[C] As per dependent claim 3, Abbo teaches a system wherein the predetermined set of physicians is physicians practicing a common specialty (Abbo; paragraph [0058]).

[D] As per dependent claim 4, Abbo teaches a system wherein the terminal server further executes the stored program to accept from the user input device of the hand-held terminal, input identifying the user, and wherein the methodology provides the most frequently used diagnosis codes for the user (Abbo; paragraph [0058]).

[E] As per dependent claim 5, Abbo teaches a system wherein the terminal server further executes the stored program to accept from the user input device of the hand-held terminal, input identifying a patient, and wherein the methodology provides most recent diagnosis codes for the patient (Abbo; paragraph [0057]).

[F] As per dependent claim 6, Abbo teaches a system wherein the terminal server further executes the stored program to accept from the user input device of the hand-held terminal, input

identifying a patient, and wherein the methodology provides diagnosis codes previously selected for the user that have not been removed by editing (Abbo; paragraphs [0057], [0058]).

[G] As per dependent claim 8, Abbo teaches a system wherein the terminal server further executes a stored program to provide the user with the ability to search for a specific diagnosis code by name of the diagnosis code (Abbo; paragraphs [0057], [0058]).

[H] Regarding claim 2-6, and 8 it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Evans and Abbo. The motivation to combine would have been to provide the physician with the option of selecting a diagnosis from a list of common diagnoses used in the particular physician's office, or diagnoses commonly used in the physician's practice which are associated with a specified organ or system as part of a specialized practice (Abbo; paragraph [0058]). Further motivation would have been to provide a comprehensive, integrated computer program application and system to manage aspects of a medical practice (Abbo; paragraph [0005]).

[I] As per dependent claim 9, Evans does not teach searching for a specific diagnostic code by name.

[J] However, Abbo does teach a system wherein the terminal server further executes a stored program to provide the user with the ability to search for a specific diagnosis code by name of the diagnosis code (Abbo; paragraphs [0042], [0057]).

[K] It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Evans and Abbo. The motivation would have been to allow the physician to enter keywords to search an entire standard list of approximately 15,000 ICD-9 diagnosis codes (Abbo; paragraph [0042]).

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Evans and Abbo as applied to claim 2 above, and further in view of Rappaport (United States Patent Application Publication #2002/0007285).

[A] As per dependent claim 16, Evans does not teach that the displayed subset is hyperlinked to a description of the diagnosis code. Abbo does teach displayed diagnosis codes are hyperlinked to select or obtain additional information about the code (Abbo; paragraph [0058]). Further, although Abbo does teach the selection of a layman's description to be associated with each diagnosis (Abbo; paragraph [0061]), Abbo does not specifically state that the description is accessible via the hyperlink.

[B] However, Rappaport teaches that for each code the database is configured to store a code description (Rappaport; paragraphs [0070] and [0071]. NOTE: Rappaport stores one or more code definitions, a code concept and other information associated with each code).

[C] It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Evans and Abbo with the teachings of Rappaport. Such combination would have allowed the user to select a diagnosis code from the list by clicking on it (Abbo; paragraph [0058]) thereby accessing stored code definitions, code concept, and other information about the code (Rappaport; paragraphs [0070] and [0071]). The motivation to combine would have been to allow the healthcare provider to access, at the point of care, diagnosis information including diagnosis codes and remarks, support information and procedure/test information that are relevant to a particular diagnosis and corresponding procedure or test (Rappaport; paragraph [0025]).

Claims 13 and 14 rejected under 35 U.S.C. 103(a) as being unpatentable over Evans and Abbo as applied to claim 2 above, and further in view of Mayaud (United States Patent #5,845,255).

[A] Regarding claims 13 and 14, Evans does not teach providing to the user a set of prewritten prescriptions prepared by a team of specialists (claim 13), nor does he teach providing a set of prewritten prescriptions being the most frequently used prescriptions by the user for the selected diagnosis code (claim 14). Although Abbo teaches the selection of diagnosis by simply clicking on it and Abbo further teaches that for each diagnosis entered, selecting a recommended treatment (Abbo; paragraphs [0056] and [0058]), Abbo does not teach that the selection of treatment includes selection of prewritten prescriptions that are prepared by a team of specialists (claim 13) or that the prescriptions are the most frequently prescribed for the user for the selected diagnosis code (claim 14).

[B] As per dependent claim 13, Mayaud does teach a system wherein the terminal server further executes a stored program to provide to the user a set of prewritten prescriptions prepared by a team of specialists (Mayaud; col. 12, lines 35-41 and col. 13, lines 13-18).

[C] As per dependent claim 14, Mayaud teaches a system wherein the terminal server further executes the stored program to accept from the user input device of the hand-held terminal, input identifying the user, and wherein the methodology provides a set of prewritten prescriptions being the most frequently used prescription by the user (Mayaud; col. 12, lines 49-56).

[D] It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Evans and Abbo with the teachings of Mayaud. Such combination would have allowed the healthcare provider to select a diagnosis and further to select a recommended treatment for the diagnosis (Abbo; paragraph [0056]). Selected treatment would have included prewritten prescriptions most commonly used for a given specialty or most commonly used for a given diagnosis (Mayaud; col. 12, lines 49-56 and col. 13, lines 13-19). The motivation would have been to provide a prescription management system, which personalizes itself to the prescribing patterns of experienced professionals (Mayaud; col. 4, lines 10-19).

(10) Response to Argument

In the Appeal Brief filed 8 February 2007, Appellant makes the following arguments:

- (A) Evans fails to teach or suggest designating a methodology for selecting a subset of diagnosis codes.
- (B) There is no motivation to combine the teachings of Evans and Abbo.
- (C) Evans and Abbo fail to teach the retrieval of the most frequently used diagnostic codes for a predetermined set of physicians.
- (D) Evans and Abbo fail to teach the retrieval of the most frequently used diagnostic codes for a predetermined set of physicians wherein the predetermined set of physicians is physicians practicing a common specialty.
- (E) Evans and Abbo fail to teach a system wherein the methodology provides the most frequently used diagnostic codes for the user.
- (F) Evans and Abbo fail to teach a system wherein the methodology provides most recent diagnosis codes for the patient.

(G) There is no motivation to combine the teachings of Mayaud with those of Evans and Abbo and the combined teachings of Mayaud, Evans, and Abbo fails to teach or suggest the claimed invention.

Examiner will address the Appellant's arguments in sequence as they appear in the Brief.

Argument (A):

In response to Appellant's first argument that the Evans reference fails to show certain features of Appellant's invention, Examiner respectfully submits that the features upon which Appellant's arguments rely are not part of the claimed invention.

Specifically, as noted by Appellant, claim 1 step (a) requires "executing a stored program to accept from the user input device of the hand-held terminal, input designating a methodology producing a subset of the diagnoses codes". While Appellant argues that "...the (present) invention provides several alternative methodologies by which the physician may zero in on specific diagnosis codes with minimum effort", Examiner respectfully submits that finally rejected claim 1 provides no recitation or indication that "several alternative methodologies" are presented to a user or further that "selection" of a methodology from "several alternative methodologies" is a required step. Examiner respectfully submits that Appellant's argument is substantially narrower in scope than the limitation presented in finally rejected claim 1. Although

Art Unit: 3623

the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Further, by Appellant's own admission, "Evans only allows a physician to receive a subset of diagnoses codes based on a single methodology: body part selection". Examiner respectfully submits that Appellant's admission regarding the functionality taught by Evans meets the requirements of the disputed limitation as presently recited in finally rejected claim 1.

Moreover, Examiner respectfully disagrees with Appellant's contention that Evans' disclosed "selection of a body system" constitutes a "single methodology". Examiner submits that a because the selection of each individual body system results in the generation of a unique subset of diagnosis codes, Evans does present the practicing physician with multiple methodologies as defined by distinct anatomical systems and their associated/relevant diagnostic codes. Therefore, while Examiner reiterates that selection of a methodology from several alternative methodologies is not presently required by finally rejected claim 1, Evans does in fact present several alternative methodologies to the user as each anatomical designation presents the user with a unique and distinct selection criteria.

Argument (B):

In response to Appellant's second argument, Examiner notes that in many, if not most, situations, there is neither a motivation to make the modification clearly articulated in the references nor an

evident lack of motivation. Rather, the prior art references typically disclose elements or aspects of the claimed subject matter, but fail to specifically point the way toward the combination, substitution or other modification needed to arrive at the invention. A judgment must be made whether "a person of ordinary skill in the art would have sufficient motivation to combine the individual [elements] forming the claimed [invention]." See *In re Clinton*, 527 F.2d 1226, 1228, 188 USPQ 365, 367 (CCPA 1976).

The teachings of both Evans and Abbo, as applied in the preceding Office Action and reiterated herein, disclose medical informatics systems/method that assist a physician in diagnosing and determining appropriate treatment for patients. Both systems serve to deliver medical record information as well as associated billing features (i.e., code selection) to the physician, at the point of care. Further, both systems seek to assist the physician in selecting the appropriate diagnostic codes by limiting the viewable diagnostic codes by relevant body part or organ system. While Evans fails to expand on different, well known means for additionally limiting sets of diagnostic codes, Abbo discusses multiple well known and convenient means of limiting code selection to sets of codes of the highest immediate relevance to the physician. By Appellant's own admission, "...Abbo teaches a very similar system to that taught by Evans." (Appellant's Brief, page 8). Examiner maintains that one of ordinary skill in the art would have been motivated to combine two functionally analogous medical informatics systems for the purpose of employing well known enhancements to the selection and determination of diagnostic codes.

Arguments (C)-(E):

In response to Appellant's third, fourth, and fifth arguments, Appellant correctly notes that Examiner relies on the teachings of Abbo at paragraph [0058] in support of rejections of claims 2-4. However, Examiner disagrees with Appellant's interpretation of the applied teachings of Abbo.

Paragraph [0058] of Abbo states "...when the physician is entering a diagnosis for a patient, the physician has the option of viewing and selecting from a list of the common diagnoses used in that particular physician's office."

By the above noted statement, Examiner respectfully submits that Abbo defines a group of physicians as physicians practicing in a specific office. Examiner further submits that because the identities of the physicians working in the specific office/practice would be known to the user, it would be obvious to one of ordinary skill in the art that the diagnoses viewed or displayed to the user, would be diagnoses commonly employed by a "predetermined set of physicians" (claim 2). Similarly, by default, a solo practitioner working alone in a designated office would resultantly use the Abbo system to view commonly used diagnoses of the single physician working in the office, i.e., codes commonly used by the individual "user" (claim 4).

Accordingly, Examiner maintains that the diagnoses commonly used by a physician or group of physicians practicing medicine in a specific medical office denotes: (1) diagnoses commonly

employed by a predetermined set of physicians and (2) diagnoses commonly employed by an individual user.

Paragraph [0058] of Abbo subsequently and independently from the above noted passage states "The physician may also have the option of displaying and selecting from a list of common diagnoses used in the particular physician's office, which are associated with a specified organ system of the body (e.g., such as musculo-skeletal, cardiovascular, skin disorders, gastrointestinal, etc.)."

As noted by Examiner, Abbo specifically includes the functionality of grouping diagnoses as those commonly employed in a physician's office *AND* as defined by specific organ system as a separate and additional functional feature. Examiner submits that the distinction made by Abbo is to provide an additional function, not a single grouped function as interpreted by Appellant.

Examiner respectfully submits that it would be obvious to one of ordinary skill in the art that medical specialties are commonly directed to specific organ or physiological systems. Using examples of "organ systems" provided by Abbo, "skin disorders" are commonly addressed by the medical specialty of Dermatology. Similarly, physicians practicing the medical specialty of Gastroenterology would commonly address gastrointestinal concerns. Accordingly, Examiner respectfully maintains that Abbo's organization of diagnoses into groupings as they pertain to a physician's medical practice and further as they pertain to a specific organ system is equivalent to

Art Unit: 3623

Applicant's sub groupings by "a predetermined set of physicians where the predetermined set is physicians practicing a common specialty" (claim 3).

Arguments (F):

In response to Appellant's sixth argument, Appellant correctly notes that Examiner relies on the teachings of Abbo at paragraph [0057] in support of the rejection of claim 5. However, Examiner disagrees with Appellant's interpretation of the applied teachings.

Abbo paragraph [0057], "With respect to the diagnosis step, the physician can select a diagnosis from the patient's previous diagnoses"

Examiner maintains it would be obvious to one of ordinary skill in the art that a patient's "previous diagnoses" denoted by Abbo, would include the patient's "most recent" diagnoses, as defined by Appellant's claim 5. Examiner admittedly fails to understand the relevance of Appellant's arguments concerning the example provided by Abbo which indicates that the patient's previous diagnoses may, for example, be derived from a file including the patient's major diagnoses.

Argument (G):

In response to Appellant's seventh argument, Examiner reiterates that in many, if not most, situations, there is neither a motivation to make the modification clearly articulated in the references nor an evident lack of motivation. Rather, the prior art references typically disclose elements or aspects of the claimed subject matter, but fail to specifically point the way toward the combination, substitution or other modification needed to arrive at the invention. A judgment must be made whether "a person of ordinary skill in the art would have sufficient motivation to combine the individual [elements] forming the claimed [invention]." See *In re Clinton*, 527 F.2d 1226, 1228, 188 USPQ 365, 367 (CCPA 1976).

The teachings of both Evans and Abbo, as applied in the preceding Office Action and reiterated herein disclose medical informatics systems/method that assist a physician in diagnosing and determining appropriate treatment for patients. Both systems include prescription management features accessible at to the physician at the point of care. Mayaud discloses a medical informatics system with enhanced prescription capabilities. The features of Appellant's claimed invention not specifically disclosed by Evans or Abbo include features well known to one of ordinary skill in the art as evidenced by Mayaud. Accordingly, Examiner maintains that the combination of Evans, Abbo and Mayaud is appropriate for the reasons cited in the previous Office Action, mailed 5 October 2006 and reiterated herein.

Art Unit: 3623

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Robert D. Rines

Examiner

/R. David RINES/

Examiner, Art Unit 3623

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